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EXAMINER

SHAAWAT, MUSSA A

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/751,216
Filing Date: January 02, 2004
Appellant(s): SIEGEL, PHILIP S.

Newgistics, Inc

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/20/2009 appealing from the Office action mailed 11/19/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A copy of each Appeal Brief filed on April 15, 2009 relating to United States Patent Application Serial No. (09/817,353) and (10/750,935) are included in Appendix C, attached in Appellants appeal brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,980,962	Arganbright	12-2005
2002/0010634	Roman	01-2002
6,246,997	Cybul	01-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

Art Unit: 3627

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-8, 10-16 and 29-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 35-46 of copending Application No. 09/817,353 referred to hereinafter as '353. Although the conflicting claims are not identical, they are not patentably distinct from each other. '353 teaches all the limitations of claims 1-5, 7-8, 10-16 and 29-32 of the present application except for generating data for printing a return label for a particular merchandise. '353 teaches initiating a return process in response to receiving the electronic selection which may include generating data for printing a return label, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit generating data for printing a return label from '353.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3627

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 7-8, 13, 15 and 30-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Arganbright et al., US Patent No. (6,980,962) referred to hereinafter as Arganbright in view of Cybul et al., US Patent No. (6246997) referred to hereinafter as Cybul.

Claim 1: Arganbright discloses a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction, (see at least col.62. line 65-col.63 line 10); In response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer, (see col. 63 lines 29-35); and in response to the electronic selection of the item, initiating a returns process for the particular item of the merchandise chosen by the consumer (see at least col.63 lines 8-11);

Arganbright does not expressly teach accessing a database to obtain transaction information associated with customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction; displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been

Art Unit: 3627

purchased by the customer in the prior purchase transaction; receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic transaction selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

However Cybul teaches accessing a computerized database to obtain the shopping or transaction history associated with the consumer (see at least Abstract, and col.4 lines 40-50); displaying the previous transaction or shopping history via a web browser interface where the previous shopping history is associated with the consumer (see at least col.3 line 65-col.4 lines 15); in response to displaying the transaction history associated with the consumer, receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in order to provide the consumer with the option to return items via internet or online.

Art Unit: 3627

Claim 2: Arganbright teaches wherein the displaying step is performed by displaying a return information web page (see col.63 lines 5-10).

As per claim 5, the limitations of claim 5 are similar to the limitations of claim 1, therefore they are rejected based on the same rationale.

Claim 7/8: Arganbright teaches a method comprising the step of accessing a database to obtain merchant return rules, and displaying at least one of the merchant return rules, (see col.63 1-10).

Claim 13: Arganbright teaches the step of notifying a merchant of the return item, (see col. 63 lines 18-22).

Claim 15: Arganbright disclose downloading the data for printing a return label to the web access tool, (see col.63 lines 30-35).

Claim 30: Arganbright teaches updating a customer profile associated with customer (see col.65 lines 7-10).

Claim 31: Arganbright teaches a method of claim 1, further comprising sending a notification to a merchant associated with a particular item of merchandise of the

Art Unit: 3627

pending return, the notification identifying the customer and the particular item of merchandise (see col.63 lines 18-22).

Claim 32: the limitations of claim 32 are similar to the limitations of claims 1, 5, and 30-31, therefore claim 32 is rejected based on the same rationale.

4. Claims 3-4 and 10-12, 14, 16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Cybul et al., in further view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

5.

Re claim 10: Arganbright nor Cybul do not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Re claim 11: Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517.

Claim 12: Arganbright nor Cybul do not expressly teach the step of performing the return is valid is performed by accessing one or more return rules associated with the

Art Unit: 3627

merchant. However Roman teaches an e-tailer establishes parameter e.g. rules to determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright the motivation being the same as in claim 10.

Claims: 14/16: Arganbright nor Cybul do not expressly teach the step of notifying a merchant of information about the customer, and the step of delivering data about the return to a customer account record. However Roman et al discloses a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged, by the processing center pp0022 line 8).

Claims 3, and 4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is hereby made final.

Claim 29: although Arganbright in view of Roman in further view of Cybul teach a customer returning/exchanging a product and accessing a database to obtain customer information such as name, receipt number, phone number and product description (see Roman et al). Neither Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information.

Examiner takes Official Notice that accessing a database to obtain customer information comprising credit card information or shipping information of a customer is well known and old in the art. It would have been obvious to modify the disclosure of Arganbright and Roman et al, to include accessing a database to obtain customer information comprising credit card information or shipping information of a customer, in order to credit the appropriate amount to the customer account or to ship back a defective product for example.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed on 05/20/2009, the appellant argues:

Argument A) the proposed combination of Arganbright and Cybul do not teach "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic transaction selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing ", (**see AB top of page 7**).

In response to Argument A) the examiner respectfully disagrees. Cybul teaches receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise for returns processing (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument B) the proposed combination of Arganbright and Cybul do not teach “in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item, the returns process initiated by a returns server” (**see AB bottom of Page 9**).

In response to Argument B) the examiner respectfully disagrees. Arganbright teaches receiving a selection of an item from the consumer the selection comprising either return or exchange of an item via a user interface and an electronic request to initiate return processing (see at least col. 63 lines 1-35). In addition Cybul teaches receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore, Arganbright in view of Cybul still meet the scope of the limitation as currently claimed.

Argument C) the proposed combination of Arganbright and Cybul do not teach “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by a customer in a prior purchase transaction” (see **AB bottom of Page 11**).

In response to Argument C) the examiner respectfully disagrees. Arganbright teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35). In addition Cybul teaches accessing a computerized database to obtain the shopping or transaction history associated with the consumer (see at least Abstract, and col.4 lines 40-50) and receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore, Arganbright in view of Cybul still meet the scope of the limitation as currently claimed.

Argument D) the proposed combination of Arganbright and Cybul do not teach “in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase

Art Unit: 3627

transaction, updating a customer profile associated with the customer” (see **AB top of Page 13**).

In response to Argument D) the examiner respectfully disagrees. Arganbright teaches updating a customer profile associated with customer (see col.65 lines 7-10). Therefore Arganbright in view of Cybul still meets the scope of the limitation as currently claimed.

Argument E) the proposed combination of Arganbright-Roman and Cybul do not teach “delivering data about the return to a customer account record” (see **AB Middle of Page 15**).

In response to Argument E) the examiner respectfully disagrees. Roman et al discloses a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged, by the processing center pp0022 line 8). Therefore Arganbright in view of Cybul in further view of Roman still meets the scope of the limitation as currently claimed.

Argument F) the proposed combination of Arganbright-Roman and Cybul do not teach “customer information comprising customer-specific credit information or customer-specific shipping” (see **AB top of Page 16**).

In response to Argument G) the examiner respectfully disagrees. The examiner would like to first direct the attention of the Appellant and the Board of Patent & Appeals that the examiner is relying an Official Notice to teach the above mentioned

Art Unit: 3627

limitation. As stated in the previous office action, "The official notice statement recited in the previous office action dated 11/29/2007, ***is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. See, MPEP 2144.02. Furthermore the Official Notice Traversal is no longer seasonable, therefore the Official Notice is considered to be admitted prior art.*** Therefore proposed combination of Arganbright-Roman-Cybul and Official Notice, still meets the scope of the limitation as currently claimed.

Argument F) the Appellant argues that there is no motivation to combine references of Arganbright in view of Cybul in view of Roman (**see AB middle of page 13 and Middle of page 17**).

In response to argument F) examiner respectfully disagrees. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at

Art Unit: 3627

the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Roman and Cybul into the disclosure of Arganbright and the results would have been predictable to one of ordinary skill in the art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MUSSA SHAAWAT/
Examiner, Art Unit
August 18, 2009

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

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